

Application No.: 09/882,109

Docket No.: 20136-00324-US

REMARKS

Claims 1-7, 9-12, 15-17 and 19 are pending in the application. Favorable reconsideration of the application is requested.

Withdrawal of the objection to the form of claim 2 is requested. Claim 2 is a process claim and includes the further limitation of prompting a user. While it is agreed that it is well known in the art that computer programs are arranged to prompt the user for a certain action, the question of whether or not the step is old in the art goes to whether or not the subject matter is patentable under 35 U.S.C. § 102 or 103, not to the form of the claim. Further limiting independent claim 1 with an additional method step of dependent claim 2 results in a method claim more limited than the independent claim.

Withdrawal of the rejection of claims 1-3 and 5-19 under 35 U.S.C. § 103 as being unpatentable over Kohler (U.S. Pat. No. 6,192,396) in view of Voticky et al. (U.S. Pat. No. 6,351,764) is requested. As set forth in the Final Rejection, Kohler teaches a process for forwarding different text messages to recipients. In accordance with the subject matter of the reference, a user can compose a message, and address different portions of the message to different recipients. While some recipients may receive the complete message, other recipients will receive only portions of the message.

Kohler does not provide for any tag which would identify to a recipient the relative importance of the e-mail to the recipient, as determined by the sender. In accordance with the rejected claims 1-3 and 5-7, the sender prepares and forwards a message to a list of recipients, and appends a tag to each recipient address identifying the relative importance to the recipient. The recipient orders the message received in accordance with the identified tag and a priority is established based on the senders (not the recipients) priorities.

Additionally, different portions of the message may be highlighted per claims 6, 9 or 19, so that different recipients receive different highlighted portions of the message.

Application No.: 09/882,109

Docket No.: 20136-00324-US

Turning now to the secondary reference to Voticky et al., a system is disclosed for sorting received information messages based on an address field. The system permits recipients to identify received electronic mail and prioritize it depending on the address of the sender. Additionally, the disclosed system utilizes a PAC (priority alphanumeric code) which identifies the priority of each of the incoming e-mail messages. Based on the stored PAC codes, the mailbox holding a received message is assigned a respective priority code. In this way, junk e-mail messages can be sent to a special mailbox of the lowest priority, and the remaining messages can be ordered according to the PAC.

The disclosed system also permits a recipient to notify a sender of a PAC, so that subsequent messages from the sender are placed in a particular priority.

However, the reference fails to disclose any structure which permits a sender to prioritize a message for a list of recipients maintained by the sender. It appears from the Voticky et al. reference that the sender can be provided with a priority code from the recipient at the recipient's discretion. There does not appear to be any system which will allow a sender to prioritize a message being sent to multiple recipients so that each recipient that receives the e-mail message has a different priority level or attention level tag embedded in the message.

Applicants also provide claims to an invention which permits highlighting different portions of the text for different recipients. This also appears not to be disclosed in the cited references.

Withdrawal of the rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Kohler in view of Voticky et al., further in view of Rochkind (U.S. Pat. No. 6,301,608) is requested. As claim 4 is dependent on claim 1, and carries all the limitations thereof, it is also believed to be allowable.

In view of the foregoing, favorable reconsideration is requested.


Application No.: 09/882,109

Docket No.: 20136-00324-US

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 09-0458, under Order No. 20136-00324-US from which the undersigned is authorized to draw.

Dated: 1/25/04

Respectfully submitted,

By 

George R. Pettit, Reg. No. 27,369
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant